

REMARKS

Claims 1-23 were rejected under the judicially created doctrine of obviousness type double patenting in view of U.S. Patent No. 6,352,531 (O'Connor et al.). The Examiner contended that the claims are not patentably distinct from each other.

Claims 1 and 13 recite “a heating catheter shaft having a proximal end and a distal end, said heating catheter shaft including at least one electrically conductive member.”

Claims 1 and 12 of O'Connor et al. recite “an optical fiber having a proximal end and a distal end.” O'Connor et al. further fails to teach or disclose a “heating catheter shaft including at least one electrically conductive member” as is claimed. The Examiner's attention is directed to MPEP section 706.02(j), indicating that the Examiner should clearly explain the grounds of the rejection for obviousness. The Examiner has not indicated the differences in Claim 1 over the applied reference cited, and the proposed modification of the applied reference necessary to arrive at the claimed subject matter, or an explanation why one of ordinary skill in the art at the time the invention was made would be motivated to make the proposed modification. Because Claims 1 and 13 require anelectrically conductive member, it is respectfully submitted that Claims 1-23 are patentably distinct from the claims and disclosure of O'Connor et al., and that the

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rejection of Claims 1-23 under the judicially created doctrine of obviousness type double patenting in view of O'Connor et al. should be withdrawn.

Claims 1-23 were rejected under 35 U.S.C. 102(e) on the grounds of anticipation by O'Connor et al. As noted above, Claims 1 and 13 recite a "heating catheter shaft including at least one electrically conductive member," and O'Connor et al. fails to teach or disclose a "heating catheter shaft including at least one electrically conductive member" as is claimed. Furthermore, 35 U.S.C. 102(e) requires that the reference cited be a published patent application or patent granted on an application "by another." It is noted that the inventors of the O'Connor et al. patent are identical to the inventors named in the present application. Furthermore, the present application is a continuation-in-part of O'Connor et al., as is stated in the "Related Applications" section of the present application. Under 37 CFR 1.78(a)(2), the claim for benefit of priority from O'Connor et al. requires that the application contain a reference to the prior application identifying it by serial number. According to 37 CFR 1.78(a)(2), "The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120." It is therefore respectfully submitted that the rejection of Claims 1-23 under 35 U.S.C. 102(e) on the grounds of anticipation by O'Connor et al. should be withdrawn.

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In light of the foregoing, it is respectfully submitted that the application is in a condition for allowance. An early favorable action is respectfully solicited.

Respectfully submitted,
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